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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,007	12/21/2000	Therese Ouellet	411044.90030	2935

7590

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EXAMINER

DAVIS, KATHARINE F

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 01/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,007

Applicant(s)

OUELLET ET AL.

Examiner

Katharine F. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19 and 28-36, drawn to nucleic acid sequences which exhibit translational regulatory activity and to constructs comprising said nucleic acid sequences, classified in Class 536, subclass 23.1 and Class 435, subclass 320.1.
- II. Claims 20-24 and 37-40, drawn to transgenic hosts comprising nucleic acid sequences which exhibit translational regulatory activity, classified in Class 800, subclasses 8 and 295 and Class 435, subclasses 252.3 and 254.11.
- III. Claims 25 and 26, drawn to a method of mediating the translational activity of a transcript, classified in Class 435, subclass 440.
- IV. Claim 27, drawn to a method of increasing the amount of protein produced in an organism, classified in Class 435, subclass 69.1.

Additionally, Applicant is required to elect one SEQ ID NO from sequences 5-9, 15, 16, 18-20, 22-24 and 26 as each SEQ ID NO represents a distinct invention as each is unrelated in terms of sequence. A search of all of the claimed sequences would be burdensome. It is noted that the claims in the elected Group will be examined only to the extent that they read on the elected SEQ ID NO.

The inventions are distinct, each from the other because of the following reasons:

Invention II is unrelated to Inventions I, III and IV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case Invention I encompasses separate, patentably distinct nucleic acid sequences, each sequence having distinct chemical and physical properties. Inventions III and IV each encompass separate methods; each method having distinct procedural steps. Invention II encompasses a transgenic host that can be used in separate experiments resulting in a different outcome than any of the other claimed inventions, for example a transgenic animal can be used as a model for defects in translational regulatory activity.

Inventions III and IV are unrelated as each encompasses a separate method with distinct procedural steps that result in different outcomes, for example the outcome of Invention III is mediation of translational activity and the outcome of Invention IV is increased protein production. The method of Invention III and the method of Invention IV can be used in separate applications.

Invention I is related to Inventions III and IV as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Invention I (nucleic acid

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sequences) can be used in many different assays and/or compositions other than in those methods of Inventions III and IV.

Furthermore, Inventions I-IV are separate and distinct as they require materially different searches, a prior art search for one of the claimed inventions will not necessarily encompass all of the claimed inventions. Because these inventions are distinct for all of the reasons discussed above and have acquired a separate status in the art because of their recognized divergent subject matter, different classification and separate search requirements, restriction for examination purposes as indicated is proper,

A telephone call was made to Nicholas Seay on January 2, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katharine F. Davis whose telephone number is (703) 605-1195 with direct desktop RightFax (703) 746-5199. The examiner can normally be reached on Monday-Friday (8:30am-5:00pm). If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications. Any inquiry of a general nature or any inquiry concerning the formalities of this application should be directed to Patent Analyst Tracey Johnson whose telephone number is (703) 305-2982.

Katharine F. Davis
January 22, 2002

DAVID GUZO
PRIMARY EXAMINER

A handwritten signature in cursive script, appearing to read "David Guzo", written over the printed name and title.